

REMARKS / ARGUMENTS:

The title of the application is amended to reflect the change in scope of the claimed invention by deleting the term “diazole”.

Claims 1, 3 – 7, 18, second claim numbered 29 and 30 - 63 were previously canceled.

Claim 19 is canceled in this Response.

Claims 12, 14 – 17, 20 – 22, 64 – 68 and 72 - 74 stand withdrawn.

Claim 2 has been amended in this Response.

Claim 2 has been amended by incorporating the description of the strobilurin-type fungicide that originally appeared in claim 19. Claim 19 has been canceled.

Claims 2, 8 – 17, 20 – 29 and 64 – 98 are in the case.

No new matter has been added.

Response to restriction requirement:

The Applicant acknowledges the new restriction requirement imposed in the Action and provisionally elects the claims of Group I (claims 2, 8 – 17, 19 – 29, 64 – 85 and 95) subject to the traversal that is described below.

The Applicant respectfully traverses the restriction requirement on the ground that search and examination of all claims would not be an undue burden for the Examiner. The reason that such search and examination would not be an undue burden is that if a thorough search is carried out for the Group I claims, then it will by necessity cover all art areas and identify all prior art that would be used in a search of all claims of Groups II and III. The Examiner, therefore, will have available all subject matter that is required for examination of the claims in the two non-elected groups, and will have a fresh knowledge of the subject matter of the present claims. Examination of all claims at the same time could be carried out efficiently and quickly. Accordingly, it is respectfully requested that the restriction requirement be reconsidered and be withdrawn.

Withdrawal of duplicate claim warning.

The withdrawal of the duplicate claim warning for claims 87 and 88 is noted with appreciation.

Withdrawal of rejection of claims under 35 USC §112, second paragraph.

The withdrawal of the rejection of claims under 35 USC §112, second paragraph, is noted with appreciation.

Maintenance of the rejection of claims 2, 9 – 11, 13 and 24 – 27 under 35 USC §102(b) over Tsuda *et al.*, BCPC Conference Pests and Diseases, 2:557 – 562 (2000).

The Office has maintained the rejection of claims 2, 9 – 11, 13 and 24 – 27 under 35 USC §102(b) as anticipated by the Tsuda *et al.* publication.

As pointed out in the Action, the Applicant, in its Response dated December 24, 2003, argued that Tsuda *et al.* teaches planting simeconazole-treated seeds or growing simeconazole treated plants in the presence of fungal plant pathogens against which simeconazole has activity, whereas the instant invention discloses treating the plant or its propagation material with an effective amount of a triazole fungicide or a strobilurin-type fungicide and planting the treated propagation material and/or growing the treated plant in the substantial absence of pest pressure by fungal plant pathogens against which the triazole or strobilurin-type fungicide is known to be active, and thereby increasing the vigor and/or the yield of the plant.

The Office now argues that in the absence of unexpected data both the prior art invention and the instant invention would have been expected to give similar results since both invention teach the same active step of applying simeconazole to plant/plant propagation material.

The Applicant respectfully traverses this position. The reasons for the traversal are that the rejection of a claim under 35 USC §102(b) requires that the prior art teach each and every claim limitation, and in the present case the Tsuda *et al.* reference does not teach the feature of planting the treated propagation material and/or growing the treated plant in the substantial absence of pest pressure by fungal plant pathogens against which the triazole or strobilurin-type fungicide is known to be active, as is required in each of the present claims. Nor is this step inherent in the method described by Tsuda *et al.*, as it is clear from the Tsuda *et al.* reference that the purpose of its seed treatment is the protection against the presence of fungal plant pathogens. See, e.g.,

statements such as “Seed treatment with simeconazole shows excellent efficacies against wheat loose smut...”, and the like, in the Tsuda *et al.* abstract. There is no teaching, suggestion, inference, or guidance provided by the Tsuda *et al.* reference that would lead a practitioner of ordinary skill to plant a seed treated with simeconazole in a location that is free of plant pathogens against which simiconazole is active. Rather, the guidance is to the contrary.

The Office appears to give weight to the “active” step of applying simeconazole to plant/plant propagation material, while ignoring the step of planting the treated seed or plant in the substantial absence of fungal plant pest pressure, which is stated in each of the presently rejected claims. It is well known that all limitations of a claim must be considered in determining the patentability of the claim. One element cannot be singled out for emphasis while another is ignored. Accordingly, it is respectfully requested that the Office give patentable weight to the step that describes planting the seeds or plants in the present claims. It is maintained that if proper weight is given to this requirement, the claims cannot be found to be anticipated by the teachings of the Tsuda *et al.* reference.

Furthermore, the Office argues that the presence of unexpected data is required to overcome the present rejection. The Applicant maintains that the presence or absence of such data is irrelevant for consideration of a rejection under 35 USC §102(b), such as the present rejection, and it is requested that the Office clarify or reconsider and withdraw this statement.

Maintenance of the rejection of claim 72 (original claim 42) under 35 USC §103(a) as obvious over Tsuda *et al.* in view of EP 067479 to Simons.

With respect, it is believed that claim 77 is meant, rather than claim 72, because claim 77 includes the features of canceled claim 42.

The Applicant reasserts the reasons that are discussed in its Response dated December 24, 2003, and those that are discussed above, which point out that Tsuda *et al.* cannot teach or suggest the claimed invention, because it does not teach or suggest the step of planting the treated seed/plant in the absence of pest pressure by a fungal plant pathogen. It is maintained that the Simons publication, which teaches the

treatment of seeds with a new, improved, flowable composition containing Captan for the purpose of protecting seeds and young seedlings against attack by fungi present in the soil does not add this teaching or suggestion. (See Background and Summary of the Simons publication; underline added for emphasis only)

It is maintained, therefore, that the rejection of claim 77 should be reconsidered and withdrawn.

Rejection of claims 2, 8 – 17, 19 – 29 and 64 – 98 under 35 USC §112, second paragraph, as being indefinite.

Claims 2, 8 – 17, 19 – 29 and 64 – 98 are rejected under 35 USC §112, second paragraph, as being indefinite because of the use of the term "strobilurin-type". Claim 2 has been amended to define the strobilurin-type fungicide to one that is selected from a listed group of fungicides, or mixtures thereof. It is believed, therefore, that this now clarifies the meaning of the term "strobilurin-type" and it is respectfully requested that the rejection be reconsidered and withdrawn.

Rejoinder of withdrawn claims:

It is respectfully requested that upon the finding that the claims are now allowable, withdrawn claims be rejoined with the case and passed to allowance.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered in view of the amendments described above and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully submitted,
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Dated: January 23, 2004

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